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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,192	11/29/2000	Shobana Biederman	SONY-50P3947	2836

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EXAMINER
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NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/727,192

Applicant(s)

BIEDERMAN ET AL.

Examiner

Qamrun Nahar

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 have been examined.

#### ***Drawings***

2. The drawings are objected to because Figure 4 contains shaded areas 222 and 224, and it is unclear whether there is any text in the shaded areas; Figure 5 contains text in the shaded areas 222 and 224, however, the text is not readable.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

#### ***Claim Objections***

4. Claim 13 is objected to because of the following informalities: "a1)" on line 3 of the claim should be deleted because there is only one step, and "a1)" indicates more than one step.

Appropriate correction is required.

5. Claim 14 is objected to because of the following informalities: "a2)" on line 3 of the claim should be deleted because there is only one step, and "a2)" indicates more than one step.

Appropriate correction is required.

6. Claim 15 is objected to because of the following informalities: "b1)" on line 3 of the claim should be deleted because there is only one step, and "b1)" indicates more than one step.

Appropriate correction is required.

7. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The subject matter of claim 15 is already contained in the subject matter of steps (b) and (c) of the parent claim 12.

8. Claim 16 is objected to because of the following informalities: "wherein step c)" on line 1 of the claim should be "wherein step b)". Appropriate correction is required.

9. Claim 16 is objected to because of the following informalities: "b2)" and "b3)" on lines 3 and 6, respectively, of the claim should be renamed/renumbered to "b1)" and "b2)", respectively, because there is only two steps.

Appropriate correction is required.

10. Claim 17 is objected to because of the following informalities: "c1)" on line 3 of the claim should be deleted because there is only one step, and "c1)" indicates more than one step.

Appropriate correction is required.

11. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The subject matter of claim 17 is already contained in the subject matter of step (c) of the parent claim 12.

12. Claim 20 is objected to because of the following informalities: "be written" on line 3 of the claim should be "to be written". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 9 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "**said** configured in said digital terminal device" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "configured in said digital terminal device".

Claim 18 recites the limitation "**said** configured in said digital terminal device" in lines 5-6 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "configured in said digital terminal device".

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by McClellan (U.S. 5,619,250).

**Per Claim 1:**

The McClellan patent discloses:

- **a media receiving system communicatively coupled to a digital terminal device, wherein said digital terminal device is a set top box configured with a default application program**  
("The present invention relates generally to set top boxes for use in an interactive television system and more particularly to an improved operating system which accommodates system upgrades in real time. The set top box system utilizes a real time, multi-tasking operating system. The system is divided into modules. Each module performs a particular function such

as a device driver, system manager, or other system function.” in column 3, lines 60-67 to column 4, line 1)

**- a media receiving apparatus coupled to said media receiving system which receives digital storage media, wherein said digital storage media is a memory stick, said memory stick containing alternative application software program to be used by said digital terminal device** (“If the system is not suitable for running a particular application program because a module, or device driver, is missing or outdated, the set top box will request that the necessary module be downloaded from the interactive television system. ... Referring now to Fig. 2, a block diagram of the system hardware for an enhanced digital audio/video interactive decoding system (40) built in accordance with the present invention is shown. The decoding system (40), or set top box, includes all of the components of the system described in Fig. 1. Additionally, the decoding system includes ... a PCMCIA interface (52) ... The PCMCIA interface (52) allows for the addition of a PCMCIA card slot which accepts PCMCIA cards. The PCMCIA cards could be used to provide a variety of enhancements such as ... system upgrades in the form of additional upgrade modules” in column 4, lines 40-44 and column 7, lines 44-65)

**- a media accessing mechanism coupled to said media receiving apparatus for accessing data contained within said digital storage media, once said digital storage media has been received by said media receiving apparatus; and a relaying component coupled to said media receiving apparatus that relays said data contained within said digital storage media to said digital terminal device** (“If a data device containing system modules were attached via

the PCMCIA interface (52) ..., the CPU could search for system module and include a description record for each module in the configuration description block as described above. The CPU could search the PCMCIA interface (52) ... either at initialization or at a later time. As a practical matter, the system would have to be initialized at least partially such that the device driver modules for the PCMCIA interface (52) ... would be loaded.” in column 9, lines 35-45).

**Per Claim 2:**

The McClellan patent discloses:

**- wherein said alternative application software program is configured as a stand-alone application software program, said stand-alone application software program adapted to be implemented in said digital terminal device instead of said default application program configured in said digital terminal device (column 4, lines 40-44 and column 7, lines 58-65).**

**Per Claim 3:**

The McClellan patent discloses:

**- wherein said alternative application software program is configured as an upgrade application software program, said upgrade application software program adapted to be written into said default application program of said digital terminal device, such that said default application is thereby upgraded (column 4, lines 40-44 and column 7, lines 58-65).**



**Per Claim 4:**

The McClellan patent discloses:

- wherein said alternative application software program is configured as a corrective application software program, said corrective application software program is adapted to be written into said default application program of said digital terminal device, such that the portion of said default application program of said digital terminal device functioning improperly is corrected such that proper functionality is restored to said default application program (column 4, lines 40-44 and column 7, lines 58-65).

**Per Claims 5-6:**

These are apparatus versions of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including "an opening in said media receiving apparatus adapted to enable said media receiving apparatus to receive media" (column 7, lines 58-65). Thus, accordingly, these claims are also anticipated by McClellan.

**Per Claim 7:**

The McClellan patent discloses:

- wherein said opening of said media receiving apparatus is such that it is integral to said digital terminal device (column 7, lines 44-65).

**Per Claim 8:**

The McClellan patent discloses:

- wherein said opening of said media receiving apparatus is of a height and width to accept said digital storage media (column 7, lines 44-65).

**Per Claims 9-11:**

These are apparatus versions of the claimed system discussed above (claims 2-4, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by McClellan.

**Per Claim 12:**

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by McClellan.

**Per Claim 13:**

The McClellan patent discloses:

- wherein said step a) further comprises the step of: inserting said digital storage media into said media receiving apparatus (column 7, lines 44-65).

**Per Claim 14:**

The McClellan patent discloses:

- wherein said step a) further comprises the step of: applying power to the digital terminal device such that said digital terminal device is thereby turned on, once said digital storage media is inserted into said media receiving apparatus (column 7, lines 44-65 and column 9, lines 35-45).

**Per Claim 15:**

The McClellan patent discloses:

- wherein said step b) further comprises the step of: accessing said data contained within said digital storage media, said data containing said alternative application software program to be used by said digital terminal device (column 4, lines 40-44 and column 7, lines 44-65).

**Per Claim 16:**

The McClellan patent discloses:

- wherein step b) further comprises the steps of: b1) said accessing of said data controlled by pre-existing instructions disposed within programmable non-volatile memory coupled to said digital terminal device (column 8, lines 12-23)

- and b2) said accessed data is disposed within the root directory of said digital storage media (column 9, lines 35-45).

**Per Claim 17:**

The McClellan patent discloses:

- wherein said step c) further comprises the step of: relaying said data containing said alternative application software program to said digital terminal device (column 9, lines 35-45).

**Per Claims 18-20:**

These are method versions of the claimed system discussed above (claims 2-4, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by McClellan.

***Conclusion***

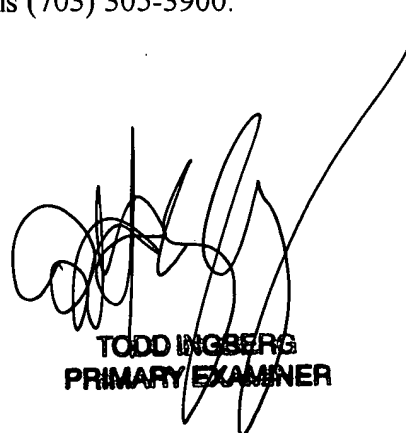
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN  
March 19, 2004



TODD INGBERG  
PRIMARY EXAMINER